

REMARKS

By this amendment, Applicants have amended claims 12, 14-16, 20, 23-26, and 31, canceled claims 17-19 and 28-30, without prejudice, and added new claims 34-43. As a result, claims 12-16, 20-27, and 31-43 are pending in this application. These amendments are being made to facilitate early allowance of the presently claimed subject matter. Applicants do not acquiesce in the correctness of the rejections and reserve the right to pursue the full scope of the subject matter of the original claims, or claims that are potentially broader in scope, in the current and/or a related patent application. Reconsideration in view of the following remarks is respectfully requested.

Initially, Applicants thank the Examiner for his time and courtesy in conducting a telephone interview with Applicants' undersigned representative on 30 June 2009. During the interview, various aspects of the objections of claims 12, 20, and 31, and rejections of claims 12-16, 20-27, and 31-33 under U.S.C. § 112 were discussed. No exhibits were demonstrated during the interview, and agreement was reached as to some of the objections and rejections as a result of the interview. The substance of the interview is included in the following remarks.

In the Final Office Action, the Office objects to claims 12, 20, and 31 for including a wherein phrase that allegedly makes the described features optional. By this response and as agreed during the telephone interview, Applicants have amended the claims to remove the wherein clause objected to by the Examiner. As a result, Applicants respectfully request withdrawal of the objection to claims 12, 20, and 31 as allegedly including an optional feature.

Further, the Office rejects claims 12-16, 20-27, and 31-33 under 35 U.S.C. § 112, first paragraph as allegedly not being enabled by the specification. In particular, the Office alleges that the specification does not discuss generating and transmitting print files and prompting the user without any further user interaction after a request to print. By this response, Applicants have amended claims 12, 20, and 31 to state that the prompting is performed without user-initiated interaction with the server.

In light of the above, Applicants respectfully request withdrawal of the objection to claims 12-16, 20-23, and 31-33 as allegedly not being enabled by the specification.

With respect to claim 24, Applicants note that claim 24 does not require that the user be prompted. Further, as discussed above, Applicants note that several portions of the specification and figures describe generating a print file and transmitting the print file to a server without further user interaction. See, e.g., specification, p. 17 and Fig. 7, 605, 610; and pp. 18-20 and Fig. 9, 506, 532. As a result, Applicants respectfully request withdrawal of the objection to claims 24-27 as allegedly not being enabled by the specification.

Additionally, the Office alleges that claims 12-16, 20-27, and 31-33 contradict themselves by stating that prompting the user to preview a bound copy of the print file is performed without further user interaction, while the claim requires that a configuration interface be requested by the user. Applicants have further amended claims 12, 20, and 31 to state that the user is prompted to configure and preview a bound copy of the document using a browser. With respect to claim 24, Applicants note that the claim does not require that the user be prompted. As a result, Applicants respectfully submit that claims 12-16, 20-27, and 31-33 do not contradict themselves.

Further, the Office rejects claims 20-27 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. In particular, the Office alleges that the claims include "means for" language that is modified by some structure, material, or acts recited in the claims. By this response and as agreed during the telephone interview, Applicants have amended the claims to remove the "means for" language. As a result, Applicants respectfully request withdrawal of the rejections of claims 20-27 as allegedly being indefinite.

Further, the Office rejects claim 28 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,134,568 (Tonkin). By this response, Applicants have canceled claim 28, without prejudice. As a result, the rejection of claim 28 as allegedly being anticipated by Tonkin is moot in view of the amendments herein. However, Applicants have added a new claim 41, which includes similar features to those of previously presented claim 28. Applicants respectfully submit that Tonkin fails to disclose generating content for a display area that concurrently includes a preview area, a navigation area, an estimate area, and a configuration area as claimed therein.

Further, the Office rejects claims 17, 19, and 31 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,615,234 (Adamske). By this response, Applicants have canceled claims 17 and 19, without prejudice. As a result, the rejections of claims 17 and 19 as allegedly being unpatentable over Adamske are moot in view of the amendments herein. However, Applicants have added claims 37-39, which include similar features as those of previously presented claims 17-19.

With respect to claim 37, Applicants respectfully submit that Adamske fails, *inter alia*, to teach or suggest obtaining document information for a document on a server

from system software, which is configured to enable a user of an application to request generation of a print file based on the document using the application, generate the print file in response to the request without further user interaction, and initiate transmitting the print file to the server in response to the generation of the print file and without user-initiated interaction with the server, generating a unique identifier for the document on the server and transmitting the unique identifier for use by the system software, and obtaining a print file on the server from the system software executing on the client subsequent to obtaining the document information as claimed therein.

Interpreting Adamske only for the purposes of this response, Adamske generally discusses two embodiments for a system and method for delivering an electronic document over a network.

In the first embodiment, discussed from column 4, line 61 through column 6, line 23 of Adamske, a user uploads an electronic document from a client computer to a web server using a web browser or email. Adamske, col. 5, lines 15-16. The electronic document is then converted to a portable printable format on an application translation server. Adamske, col. 5, lines 18-19. In order to perform the conversion, “the application translation program [on the application translation server] houses the variety of client applications that users use to create electronic documents.” Adamske, col. 5, lines 19-21. The converted printable electronic document is then transmitted to a web server, where it is processed to create web-viewable print preview files. Adamske, col. 5, line 64-col. 6, line 3. The user can use the client-side web browser to preview the document. Adamske, col. 6, lines 12-15.

In the second embodiment, discussed from column 6, lines 24-57 of Adamske, “the client computer includes a print driver program... that is executable to convert the electronic document and provide the print preview capability prior to uploading to the web server.” Adamske, col. 6, lines 34-38. In particular, the print driver program creates a metafile from the electronic document, which provides a viewable representation of how the document will look upon printing. Adamske, col. 6, lines 46-49. Subsequently, the user “sends this metafile to [the application] translation server through web server and the conversion into a printable (e.g., PostScript) version is performed as previously described.” Adamske, col. 6, lines 49-52.

To this extent, contrary to both embodiments of Adamske, in which a printable version of a file is generated on an application translation server, a print file is obtained from system software executing on a client in claim 37. Further, the invention provides system software configured to generate the print file in response to a request generated by a user using an application without further user interaction and initiate transmitting the print file to the server in response to the generation of the print file and without user-initiated interaction with the server. In contrast, in Adamske, the print driver program first performs the print preview, and the user must subsequently send a metafile to the application translation server for conversion to the printable version.

In light of the above, Applicants respectfully submit that claim 37, and claims 38-40, which depend therefrom, are patentable over Adamske.

With respect to claim 31, in view of Applicants' amendments and remarks above with respect to the objection and rejection of claim 31 as allegedly being indefinite, Applicants respectfully submit that claim 31 is allowable as indicated in the Final Office

Action. Final Office Action, p. 4, lines 6-9. As a result, Applicants respectfully request withdrawal of the rejection of claim 31 as allegedly being unpatentable over Adamske.

Further, the Office rejects claims 12-16, 18, 20-27, 29, 30, 32, and 33 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 12, in view of Applicants' amendments and remarks above with respect to the objection and rejection of claim 12 as allegedly being indefinite, Applicants respectfully submit that claim 12 is allowable as indicated in the Final Office Action. Final Office Action, p. 4, lines 6-9. As a result, Applicants respectfully request withdrawal of the rejections of claim 12 and claims 13-16 and 32-33 as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claims 18, 29, and 30, by this response, Applicants have canceled claims 18, 29, and 30, without prejudice. As a result, the rejections of claims 18, 29, and 30 as allegedly being unpatentable over Adamske in view of Tonkin are moot in view of the amendments herein. However, Applicants have added new claims 38 and 42-43, which include similar features as claims 18 and 29, respectively.

With respect to claim 38, Applicants incorporate the arguments presented above with respect to claim 37. Further, Applicants submit that the proposed combination of Adamske with Tonkin fails to address the deficiencies of Adamske discussed above with respect to claim 37. As a result, Applicants respectfully submit that claim 37 is patentable over Adamske in view of Tonkin.

With respect to claim 42, for reasons that should be obvious in view of the discussion of Adamske and Tonkin above, Applicants respectfully submit that the proposed combination of Adamske and Tonkin fails to teach or suggest the program

code for generating, program code for transmitting, and program code for prompting as claimed therein. As a result, Applicants respectfully submit that claim 42 and claim 43, which depends therefrom, are patentable over Adamske in view of Tonkin.

With respect to claim 20, in view of Applicants' amendments and remarks above with respect to the objection and rejection of claim 20 as allegedly being indefinite, Applicants respectfully submit that claim 20 is allowable as indicated in the Final Office Action. Final Office Action, p. 4, lines 6-9. As a result, Applicants respectfully request withdrawal of the rejections of claims 20 and claims 21-23, which depend therefrom, as allegedly being unpatentable over Adamske in view of Tonkin.

With respect to claim 24, in view of Applicants' amendments and remarks above with respect to the rejection of claim 24 as allegedly being indefinite, Applicants respectfully submit that claim 24 is allowable as indicated in the Final Office Action. Final Office Action, p. 4, lines 6-9. As a result, Applicants respectfully request withdrawal of the rejections of claims 24 and claims 25-27, which depend therefrom, as allegedly being unpatentable over Adamske in view of Tonkin.

Applicants submit that each of the pending claims is patentable for one or more additional unique features. To this extent, Applicants do not acquiesce to the Office's interpretation of the claimed subject matter or the references used in rejecting the claimed subject matter. Additionally, Applicants do not acquiesce to the Office's combinations and modifications of the various references or the motives cited for such combinations and modifications. These features and the appropriateness of the Office's combinations and modifications have not been separately addressed herein for brevity. However, Applicants reserve the right to present such arguments in a later response

should one be necessary and/or in a related patent application, either of which may seek to obtain protection for claims of a potentially broader scope.

In light of the above, Applicants respectfully submit that all claims are in condition for allowance. Should the Examiner require anything further to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the number listed below.

Respectfully submitted,

/John LaBatt/

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Dated: 4 September 2009